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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,498	03/08/2004	James D. Charasika	439070100	2497
20322	7590	09/27/2006	EXAMINER	
SNELL & WILMER 400 EAST VAN BUREN ONE ARIZONA CENTER PHOENIX, AZ 85004-2202			BATTULA, PRADEEP CHOUDARY	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/708,498	Applicant(s) CHARASIKA, JAMES D.	
	Examiner Pradeep C. Battula	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/8/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Information Disclosure Statement

One reference on the Information Disclosure Statement was not considered based on the reference existing in a non-relevant art.

Claim Objections

Claim 5 is objected to because of the following informalities: The word "second" located in line 4 should be changed to "first". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldershof (U.S. 3,145,841) in view of Donovan (U.S. 3,620,553).

In regards to Claim 1, Aldershof discloses a system for selective collection of information comprising: a first complete information collection sheet 1a, including a first portion (Figure 4, Item 17') for collection of a first information and a second portion (Figure 4, Item 17') for collection of a second information (Column 4, Lines 23 – 36), said first portion (top portion of sheet 1a) including a first select information section (bottom portion of sheet 1a) (Figure 4, Item 17'); a

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second complete information collection sheet 1b underlying said first complete information collection sheet in overlapping position, wherein a top edge of said second complete information collection sheet is substantially aligned with a bottom edge of said first select information collection section of said first complete information collection sheet (Column 3, Lines 11 – 16; Figure 1, refer to common rings 15 and dashed lines), said second complete information collection sheet including a third portion (top portion of sheet 1b) for collection of a third information and a fourth portion (bottom portion of sheet 1b) for collection of a fourth information (Column 4, Lines 23 – 36) said third portion including a second select information section.

With respect to select information sections examiner has designated areas of different indicia as presented by the reference. Furthermore, Aldershof discloses the above claimed subject matter except for the specific arrangement and/or content of indicia (select information) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets comprising information is the same structure claimed by applicant and the sole difference is in the

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content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (select information) and the substrate (overlapping sheets) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Aldershof does not disclose a reproduction enabling media underlying said first and second complete information collection sheets, said reproduction enabling media in direct communication with said first and second select information section; and a record data sheet underlying said enabling media, said record data sheet in communication with said reproduction enabling media.

Donovan teaches of a reproduction media (not numbered) associated with a record sheet 662 underneath a secure document (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10) where select information is duplicated. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Donovan's reproduction media and record sheet in the select information locations of Aldershof's invention in order to allow for one to have select information in a permanent record (Column 13, Lines 64 – 68).

In regards to Claim 2, as applied to Claim 1, Aldershof modified by Donovan further discloses said first 1a and second 1b complete collection information sheets are individually removable with the first complete information

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collection sheet removable prior to the second complete collection information sheet being removable (Column 4, Lines 23 – 36; Figures 1, 4 of Aldershof).

In regards to Claim 3, as applied to Claim 1, Aldershof modified by Donovan further discloses the reproduction media and record sheet are detachably affixed to one another as well as to the documents from which the information is duplicated (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10 of Donovan).

In regards to Claim 4, as applied to Claim 1, Aldershof modified by Donovan discloses the claimed invention except for the specific arrangement and/or content of indicia (instructions) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with instructive indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (instructive indicia) and the substrate (overlapping sheets) which is required for patentability.

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Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 5, as applied to Claim 4 and further disclosed in Claim 1, Aldershof modified by Donovan further discloses that information provided to said first select information section (Column 3, Lines 11 – 16 of Aldershof) is provided to said reproduction enabling media and information provided to said second portion is provided to said first complete information collection sheet.

In regards to Claim 6, as applied to Claim 5 and further disclosed in Claim 1, Aldershof modified by Donovan further discloses information provided to said second select information section is provided to said reproduction enabling media and information provided to said fourth portion (Column 4, Lines 23 – 36 of Aldershof) is provided to said second complete information collection sheet.

In regards to Claim 7, as applied to Claim 6 and further disclosed in Claim 1, Aldershof modified by Donovan further discloses said first complete information collection sheet is detached prior to providing the information to the second select information section (Column 4, Lines 35 – 50 of Aldershof).

Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In regards to Claim 8, as applied to Claim 5, Aldershof modified by Donovan further discloses said first select information section information is

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provided from said reproduction enabling media (not numbered) to said record data sheet 662 in real-time (Column 14, Lines 1-10 of Donovan). This is inherently taught since pressure sensitive reproduction media can be used on form 662 or and additional carbon sheet.

In regards to Claim 9, as applied to Claim 8, Aldershof modified by Donovan further discloses said first select information section information is provided to said reproduction enabling media (not numbered) in real-time (Column 14, Lines 1-10; Donovan) This is inherently taught since pressure sensitive reproduction media can be used on form 662 or and additional carbon sheet.

In regards to Claim 10, as applied to Claim 8, Aldershof modified by Donovan discloses the claimed invention matter except for the specific arrangement and/or content of indicia (identifier) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of identifier does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets with reproduction media comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and

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unobvious functional relationship between the printed matter (identifier) and the substrate (overlapping sheets and reproduction media) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 11, as applied to Claim 7, Aldershof modified by Donovan further discloses the second select information section information is provided from said reproduction enabling media to said record data sheet in real-time (Column 14, Lines 1-10; Donovan). This is inherently taught since pressure sensitive reproduction media can be used on form 662 or and additional carbon sheet.

In regards to Claim 12, as applied to Claim 11, Aldershof modified by Donovan discloses the claimed invention matter except for the specific arrangement and/or content of indicia (identifier) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of identifier does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

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The examiner asserts that the overlapping sheets with reproduction media comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (identifier) and the substrate (overlapping sheets and reproduction media) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 13, Aldershof discloses a system for selective collection of information comprising: a plurality of complete information collection sheets stacked in overlapping manner (Column 3, Lines 11 – 16; Figure 1, refer to common rings 15 and dashed lines), wherein each one of said plurality of complete information sheets includes a first portion (bottom portion of sheet 1a) for collection of select information and a second portion (top portion of sheet 1a) for collection of nonselective information (Column 4, Lines 23 – 36; Figure 4). Further disclosed is said plurality of complete information collection sheets positioned such that a top edge of each underlying one of said plurality of complete information collection sheets is substantially aligned with the bottom edge of the first portion of the next preceding overlying one of said plurality of complete information collection sheets, said plurality of complete collection sheets (Column 3, Lines 11 – 16; Figure 1, refer to common rings 15 and dashed lines).

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Aldershof does not disclose a reproduction enabling media underlying said plurality of complete information collection sheets, said reproduction enabling media in contact with said first portion of each one of said plurality of complete information collection sheets; and a record data sheet underlying said reproduction enabling media. Also not disclosed is the reproduction enabling media and record data sheets being immovably positioned one to the other.

Donovan teaches of a reproduction media (not numbered) associated with a record sheet 662 underneath a secure document (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Donovan's reproduction media and record sheet in the desired location Aldershof's invention in order to allow for one to have secure information in a permanent record (Column 13, Lines 64 – 68). Donovan also teaches that the reproduction enabling media and record data sheets being immovably positioned one to the other (Column 14, Lines 1 – 5). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Donovan's reproduction media and record sheet in the select information locations of Aldershof's invention in order to allow for one to have select information in a permanent record with minimal amount of extra material (Column 13, Lines 64 – 68).

In regards to Claim 14, as applied to Claim 13, Aldershof modified by Donovan further discloses that each one of the plurality of complete information

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collection sheets is individually detachable from the remaining sheets (Column 4, Lines 23 – 36; Figures 1, 4; Aldershof).

In regards to Claim 15, as applied to Claim 14, Aldershof modified by Donovan further discloses information provided to said first portion is provided to said reproduction enabling media (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10; Donovan).

Furthermore, Aldershof modified by Donovan discloses the claimed invention except for the specific arrangement and/or content of indicia (instructions) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with instructive indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the overlapping sheets comprising information is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (instructive indicia) and the substrate (overlapping sheets) which is required for patentability.

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Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 16, as applied to Claim 15, Aldershof modified by Donovan further discloses said first portion includes instructions for providing information to said first portion, said information provided to said first portion is provided to said reproduction enabling media (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10; Donovan).

In regards to Claim 17, Aldershof discloses a method for select collection of information, comprising: using one of a plurality of complete information sheets (1a – 1d) to provide information (Figure 4), the plurality of complete information collection sheets being arranged in overlapping manner such that topmost sheet is obscuring a first portion of the next successive underlying sheet (Column 4, Lines 23 – 36). Further disclosed is that removing a topmost one of the plurality of complete collection sheets to provide information to the next successive underlying sheet is required (Column 4, Lines 23 – 36; Figure 4).

Aldershof does not disclose the plurality of sheets further arranged such that a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media. Also not disclosed reproducing, on a record data sheet in real-time, information provided to the portion of each plurality of complete information collection sheets.

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Donovan discloses a plurality of sheets such that a portion of each sheet is in contact with a reproduction enabling media (not numbered) for reproducing the information provided to the portion of each sheet in contact with the media and reproducing, on a record data sheet 662 in real-time, information provided to the portion of each plurality of complete information collection sheets (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Donovan's reproduction media and record sheet in the information locations of Aldershof's invention in order to allow for one to have the input information in a permanent record (Column 13, Lines 64 – 68).

With this modification, the first sheet is filled out and has the information reproduced and then the user goes to the second sheet as disclosed in Aldershof and the process is repeated as disclosed by applicant.

In regards to Claim 18, Aldershof discloses a method for select collection of information, comprising: arranging a plurality of sheets in an overlapping manner such that the topmost sheet is obscuring a first portion of the next successive underlying sheet of the plurality of sheets Column 4, Lines 23 – 36).

Aldershof does not disclose arranging the plurality of sheets such that a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media; and enabling the reproduction, in real-time on a record data sheet, information provided to the portion of each plurality of complete information collection sheets.

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Donovan discloses a plurality of sheets such that a portion of each sheet is in contact with a reproduction enabling media (not numbered) for reproducing the information provided to the portion of each sheet in contact with the media and enabling the reproduction, in real-time on a record data sheet 662, information provided to the portion of each plurality of complete information collection sheets (Column 13, Lines 53 – 75; Column 14, Lines 1 – 10). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Donovan's reproduction media and record sheet in the information locations of Aldershof's invention in order to allow for one to have the input information in a permanent record (Column 13, Lines 64 – 68).

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
September 19, 2006

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER